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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/302,552	04/30/1999	STEPHEN SAVITZKY	015358-004600US	7040
20350 7590 12/12/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER NGUYEN, MAIKHANH	
			ART UNIT 2176	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

mn

Office Action Summary

Application No.

09/302,552

Applicant(s)

SAVITZKY ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/2/07 & 11/9/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to Appeal Brief filed 09/24/2007.


Claims 1-13 are presented for examination. Claims 1 and 9 are independent claims.

In view of the Appeal Brief filed on 09/24/2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection s set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.



DOUG HUTTON
SUPERVISORY PATENT EXAMINER

Claim Objections

2. Claims 1 and 9 are objected to because of the following informalities: the phrase
- As to claim 1: "*at least two electronic documents*" (line 11) should read "*the at least two electronic documents*"; and
 - As to claim 9, "*a secured stack*" (line 14) and should "*the secured stack*" (lines 15-17) read "*the secured stack object.*"

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 4, the term "*a user*" is indefinite. It is unclear if it is referring to "*a user*" recited in claim 1.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claims 1 and 9 recite "*generating a staple data object, for representing an association of selected pages of at least two selected documents*" These claimed limitations merely specify an intended use or field of use for the invention. Statements of intended use are not patentably limiting. As such, the claimed invention is directed to non-statutory subject matter.

Dependent claims 2-8 and 10-13 are rejected for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ferguson** (US 6820094, filed 10/1997) in view of **Khan et al.** (US 6401206, filed 03/1998), and further in view of **Schmid et al.** (US 5659164, issued 08/1997).

As to claim 1:

An intended use of a claimed device does not limit the scope of the claim. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (product claim's intended use recitations not given patentable weight); see also Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1345, 65 USPQ2d 1961, 1965 (Fed. Cir. 2003) ("An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates."). Although "[s]uch statements often... appear in the claim's

preamble," In re Stencel, 828 F.2d 751,754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. Id.

Initially, it is noted that the claim limitation "*for representing an association of selected pages of at least two selected documents*" is merely an intended use of the recited "*a staple data object*". Therefore, this limitation is not entitled to patentable weight.

However, even if this limitation is given patentable weight it is met by Ferguson.

Ferguson teaches in an electronic document handling system, a method of manipulating (*manipulate*) documents (*electronic documents*) [*see the Abstract*] comprising the steps of:

- generating a staple data object (*e.g., a clipped document*), for representing an association of selected pages of at least two selected documents [*col.4; line 29 - col.5, line 14 and col.11, line 36- col.13, ln.6*];
- generating an electronic cover sheet (*e.g., a property sheet*) for the staple data [*col.19; lines 1-55*];
- accepting from a user (*e.g., user*) a list of at least one page of at least two electronic documents (*e.g., documents*) [*col.11; line 21- col.12, line 57*];
- referencing each page or each electronic document in the list as an item of the staple data object (*e.g., a clipped document is created, an STG filed is generated. Unlike STG files associated individual documents; col.4; lines 29-57 and col.6; lines 38-62*);

- accepting a staple instruction from a user (*col.16; line 11 - col.17, line 11*).

Ferguson does not specifically teach the claimed “*cryptographically securing*”.

Khan teaches cryptographically securing the combination of the pages of at least two electronic documents (*see col.3, lines 48-52*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ferguson with Khan because it would have provided the capability for efficiently creating a digital identity of an individual that can be used in electronic authentication systems for signing the electronic documents.

The combination of Ferguson and Khan, however, does not specifically teach the use of an unalterable indicator.

Schmid teaches the use of an unalterable indicator (*see the Abstract, col.4, lines 38-37, and col.5, line 29-col.6, line 3*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Schmid with Ferguson as modified by Khan because it would have allowed the use of a novel cover page having machine-readable coded information that contains the network address or identifier for the document owners to

whom the document should be assigned or routed, as well as settings for the scanner and/or additional operations to be performed, with electronic scanner-computer response to all such information.

As to claim 2:

Ferguson teaches accepting a manually input list (*col.6, lines 5-62*).

As to claim 3:

Ferguson teaches accepting a computer-generated list (*col.11, line 22-col.12, line 57*).

As to claim 6:

Ferguson teaches copying the selected pages and selected documents in a stack to static storage (*col.3, line 60-col. 4, line 56; col.5, line 41- col.6, line 2; and col.7, line 63-col.8, line 65*).

As to claim 7:

Ferguson teaches copying the selected pages and selected documents in a stack to a local storage device local to the electronic document handling system (*col.3, line 60-col. 4, line 56; col.5, line 41- col.6, line 2; and col.7, line 63-col.8, line 65*).

As to claim 8:

Ferguson teaches displaying a first list of documents, wherein the first list of documents lists the documents that are selected for inclusion in an open stack (col. 9, lines 10-26); displaying a second list of document, wherein the second list of documents list documents that have not been selected for inclusion in an open stack; and displaying a user interface control operative to obtain selections from a user of documents from the second list for inclusion in an open stack (*col.17, lines 1-13*).

As to claim 9:

The rejection of independent claim 1 above is incorporated herein in full. Additionally,

Ferguson teaches:

- opening a stack upon receipt of a stack open instruction (*col.17, lines 1-13*);
- presenting the contents of the stack for perusal by the user (*col.9, lines 10- 26 and col. 11, line 23-col.12, line 57*);
- accepting additions and deletions of items on the stack (*col.9, lines 25-47*); and
- stack upon receipt of a stack restaple operation (*col.16; line 11 - col.17, line 11*).

Refer to the discussion of claim 1 above for rejection of securing.

As to claim 10:

Khan teaches using a stack signature to secure the stack object, wherein the stack signature is a checksum of the contents of all the selected pages and selected documents in the stack, signed by the digital signature of a user or the digital signature or private key of a system (*see the Abstract and col.3, lines 48-52*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ferguson with Khan because it would have provided the capability for efficiently creating a digital identity of an individual that can be used in electronic authentication systems for signing the electronic documents.

As to claim 11:

Ferguson teaches storing the electronic cover sheet in a stack database, where it can be referenced (*col.19, lines 1- 55*).

As to claim 12:

Ferguson teaches generating controls for adding and deleting selected pages and selected documents from the stack (*col.5, lines 15-67; col.9, lines 27-48*).

As to claim 13:

Schmid teaches the electronic cover sheet includes a visual indication that the existence of the association of selected pages and selected documents together at one time (*see the Abstract, col. 4, lines 38-37, and col. 5, line 29-col. 6, line 3*).

Refer to discussion of claim 1 above for rejection of “cryptographically securing”.

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ferguson** in view of **Khan et al.**, and **Schmid et al.** as applied to claims 1 and 9 above and further in view of **IBM** “Technical Disclosure Bulletin”, issued 07/1992).

As to claim 4:

The combination of Ferguson, Khan, and MacPhail does not specifically teach “presenting a user with an online form as an aid to selecting pages or documents for association as a stack.”

IBM teaches presenting a user with an online form as an aid to selecting pages or documents for association as a stack (*e.g., on-line documents ... the need for an on-line stapler; page 1*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine IBM's teaching with Ferguson as modified by Khan and MacPhail because it would have provided the capability for quickly and easily associating on-line, soft copy documents to another.

As to claim 5:

The combination of Ferguson, Khan, and MacPhail does not specifically teach *"prompting for the staple instruction by presenting the user with a stapler icon which, when selected, represents the staple instruction."*

IBM teaches prompting for the staple instruction by presenting the user with a stapler icon which, when selected, represents the staple instruction (*e.g., a small stapler icon ... The user selects the stapler icons; page 1*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine IBM's teaching with Ferguson as modified by Khan and MacPhail because it would have provided the capability for quickly and easily associating on-line, soft copy documents to another.

Response to Arguments

8. Applicant's arguments filed 09/24/2007 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

Contact information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MN

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PRIMARY EXAMINER